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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Simone Mazzoni et al.
Application No. : 10/761,708
Filed : January 21, 2004
For : GENERATION OF A GUARD INTERVAL IN A DMT
MODULATION TRANSMISSION

Examiner : Toan D. Nguyen
Art Unit : 2416
Patent No. : 7,633,851
Issued : December 15, 2009
Docket No. : 859063.462C1
Date : February 16, 2010

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**UNDER 37 C.F.R. § 1.705(d)**

Commissioner for Patents:

Applicants hereby request reconsideration of the patent term adjustment under 35 U.S.C. § 154(b) indicated on Patent No. 7,633,851 issued by the U.S. Patent and Trademark Office (PTO) on December 15, 2009. As required under 37 C.F.R. § 1.705(b)(1).

Because this Request for Reconsideration of Patent Term Adjustment depends on calculations based on the issue date of the patent, this Request relates to an issue that could not have been raised prior to issuance of the patent. Therefore, this Request is timely filed within two months of the issue date (December 15, 2009) of U.S. Patent No. 7,633,851, in accordance with 37 C.F.R. § 1.705(d).

Application No. 10/761,708
Request for Reconsideration of Patent Term Adjustment

Statement of Facts (37 C.F.R. § 1.705(b)(2)):

The adjustment of patent term under 35 U.S.C. 154(b) that is indicated in U.S. Patent No. 7,633,851 is 1197 days. As discussed in detail below, Applicants respectfully submit that this adjustment is incorrect and request an addition of 609 days to the patent term of U.S. Patent No. 7,623,837. Accordingly, the correct adjustment of patent term under 35 U.S.C. 154(b) is 1806 days.

(i) Applicants submit that the patent term adjustment for delay by the U.S. Patent and Trademark Office (PTO) under 37 C.F.R. § 1.702(a) is 1197 days and for delay by the PTO under 37 C.F.R. § 1.702(b) is 1059 days. Accordingly, Applicants submit that the correct sum of delays by the PTO is 2256 days and is reduced by 450 days of overlap of PTO delays under 37 C.F.R. § 1.702(a) and 37 C.F.R. § 1.702(b). Accordingly, Applicants submit that the correct sum of the delays by the PTO is 1806 days.

(ii) Delays by the PTO under 37 C.F.R. § 1.702(a) equal 1197 days. The above-identified patent was filed under 35 U.S.C. 111 and has a filing date of January 21, 2004. A delay of 1197 days is accorded under 37 C.F.R. § 1.702(a)(1) with respect to issuance of an Office Action containing Claim Rejections on June 30, 2008.

Applicants submit that the delay by the PTO under 37 C.F.R. § 1.702(b) is not zero (0) days as indicated in Patent Application Information Retrieval (PAIR) but is 1059 days. The filing date under 35 U.S.C. § 111 was January 21, 2004. Three years after this date was January 21, 2007; however, the patent issued on December 15, 2009. In accordance with 37 C.F.R. § 1.702(b), issuance of the patent has been delayed by the PTO by 1059 days after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111 (*see also* 37 C.F.R. § 1.703(b)).

Under 35 U.S.C. § 154(b)(2)(A), to the extent that periods of delay attributable under 35 U.S.C. § 154(b)(1) overlap, the period of adjustment shall not exceed the number of days that issuance of the patent was delayed. Since the first action was mailed on June 30, 2008,

Application No. 10/761,708
Request for Reconsideration of Patent Term Adjustment

450 days after the start of the three year date on January 21, 2007, 450 days of delay by the PTO under 37 C.F.R. § 1.702(a)(1) overlaps with the greater than three year period. Therefore, a delay of 609 days does not overlap with delay by the PTO under 37 C.F.R. § 1.702(b) between June 30, 2008 and December 15, 2009 (*see Wyeth and Elan Pharma Intn'l Ltd. V. Kappos*, 2009-1120 (Fed. Cir. 2010), and *Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538, 1541 (D.D.C. 2008)).

Accordingly, the total delay of 2256 days (1197 days + 1059 days) by the PTO under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) is reduced by 450 days in accordance 37 C.F.R. § 1.702(b)(1) and 35 U.S.C. § 154(b)(2)(A) and equals 1806 days.

Applicants submit that, in total, the delay by the PTO under 35 U.S.C. § 154(b) and 37 C.F.R. § 1.702 equals 1806 days (1197 days + 1059 days – 450 days).

(iii) This patent is not subject to any terminal disclaimer.

(iv) Pursuant to 37 C.F.R. § 1.704(b), the period of adjustment of patent term is decreased by zero (0) days due to delays by Applicant. As indicated in PAIR, an Office Action containing Claim Rejections was mailed by the PTO on June 30, 2008. Applicants submitted a reply to the Office Action on September 30, 2008 (a delay of 0 days). A second Office Action containing Claim Rejections was mailed on January 9, 2009. Applicants submitted a reply to the Office Action on April 9, 2009 (a delay of 0 days). In response, a Notice of Allowance was mailed August 4, 2009. The Notice of Allowance indicated that none of the Certified copies of priority documents were received by the PTO. Applicants submitted the Issue Fee Payment on November 3, 2009 (a delay of 0 days) with Comments Regarding Priority Documents indicating that the certified copies of the priority documents were submitted in the parent application 09/491,685. In response, a Supplemental Notice of Allowance was mailed November 24, 2009, which required no response by Applicants.

Accordingly, Applicants' delays under 37 C.F.R. § 1.704(b) equal zero (0) days.

(v) Pursuant to 37 C.F.R. § 1.704(c), the period of adjustment of patent term is

Application No. 10/761,708
Request for Reconsideration of Patent Term Adjustment

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not decreased due to delays by Applicants.

Summary

In view of the foregoing, Applicants are entitled to a patent term adjustment of 1806 days. Applicants respectfully request an addition of 609 days.

The Director is authorized to charge any additional fees due by way of this Application, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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